



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 6

TESTA, HURWITZ & THIBEAULT, LLP
HIGH STREET TOWER
125 HIGH STREET
BOSTON MA 02110

COPY MAILED

JUN 28 2002

OFFICE OF PETITIONS

In re Application of
Zillies, et al.
Application No. 10/055,565
Filed: October 26, 2001
Attorney Docket No. MIT-051CN2

LETTER

This is a letter in response to the paper entitled, "RESPONSE TO NOTICE TO FILE CORRECTED APPLICATION PAPERS," filed April 1, 2002 (certificate of mailing date March 21, 2002) requesting that pages 7 and 9 submitted on April 1, 2002 (certificate of mailing date March 21, 2002) be accorded a filing date of October 26, 2001.

The application was filed on October 26, 2001. On March 4, 2002, the Office of Initial Patent Examination mailed a Notice to File Corrected Application Papers stating that pages 7 and 9 of the specification appeared to have been omitted. In addition, the Notice required submission of substitute drawings in compliance with 37 CFR 1.84.

In response to the Notice, petitioners timely filed 13 pages of substitute drawings and a paper entitled, "RESPONSE TO NOTICE TO FILE CORRECTED APPLICATION PAPERS" (Response). The Response states two possible grounds for granting the requested October 26, 2001 filing date to pages 7 and 9 of the specification.

First, petitioners state that a stamped return receipt postcard is evidence that pages 7 and 9 were filed on October 26, 2001. A thorough review of the application file did not uncover the stamped return receipt postcard. It is noted that petitioners are reserving their right to petition. If petitioners wish to rely on postcard practice, rather than incorporation by reference, to obtain an October 26, 2001 filing date for pages 7 and 9, a copy of the postcard should be submitted, as well as the \$130.00 petition fee, which will be refunded if it is shown that pages 7 and 9 were present upon filing.

Second, petitioners request that pages 7 and 9 of the specification be accorded a filing date of October 26, 2001 because the above-identified patent application is a divisional of application no. 09/324,137 and the entire contents of application no. 09/324,137 was specifically incorporated by reference into the above-identified application when the above-identified application was filed.

Petitioners are correct in that the Office allows an applicant to rely upon an incorporation by reference of a parent application when a portion of the child application has been inadvertently omitted.

MPEP 201.06(c) states that:

... an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or


applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

Pages 7 and 9 submitted with the petition will not be entered at this time. The original application papers will include only those application papers present on the date of deposit.

The Application is being returned to the Office of Initial Patent Examination for further processing with a filing date of October 26, 2001, using only the application papers filed on October 26, 2001.

Thereafter, the application will be forwarded to the appropriate group art unit for consideration by the examiner of the RESPONSE TO NOTICE TO FILE CORRECTED APPLICATION PAPERS, as an amendment requesting the entry of pages 7 and 9. The pages will be reviewed by the examiner for new matter. See MPEP 608.02(a).

Telephone inquiries should be directed to Petitions Attorney E. Shirene Willis at (703) 308-6712.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy